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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/541,303

06/30/2005

Chen Cai Huang

MR3483-9

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05/07/2008

ROSENBERG, KLEIN & LEE

3458 ELLICOTT CENTER DRIVE-SUITE 101

ELLICOTT CITY, MD 21043

EXAMINER

TAOUSAKIS, ALEXANDER P

ART UNIT

PAPER NUMBER

3726

MAIL DATE

DELIVERY MODE

05/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |   |  |  |
|------------------------------|---|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/541,303      | <b>Applicant(s)</b><br>HUANG, CHEN CAI |  |
|                              | <b>Examiner</b><br>ALEXANDER P. TAOUSAKIS | <b>Art Unit</b><br>3726                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/30/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 1-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/29/2007.

### ***Drawings***

Figures 1-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 17-27 are objected to because of the following informalities: Claim 17: "spectacle frame" should be changed to --a spectacle frame--. Claims 18-27: "of resilient hinge of spectacle" should be changed to --of a resilient hinge of a spectacle--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 recites the limitations "the positioning guide, resilient medium, and stopper" in lines 2-3. There is insufficient antecedent basis for these limitations in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 17-18, 21-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mossner et al (5,822,840).**

17. Mossner et al teach a manufacturing method for a resilient hinge of spectacle frame, which comprises at least the following steps: primary shaping step: the axis having a primary shape manufactured from a metal sheet that the head end of the axis is a male hinge structure (*see Figures 18 and column 11 lines 19-20*) the middle part (*the portion between 9 and 11*) is a square pillar with a comparatively smaller cross-sectional area and the rear part (9) is a square pillar (*see Figure 18 II which shows the cross-section column 11 lines 21-23*); diameter-reducing: processing the rear square

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pillar of the axis having the primary shape into a circular pillar with specified diameter value by compressing and stretching simultaneously (*see column 10 lines 56-58, and note that stamping dies will inherently compress and stretch the pillar*); processing a hinge hole: making a hole at the head of the axis (*see Figure 17 and column 10 lines 63-65*).

18: Mossner et al teach the manufacturing method of a resilient hinge of spectacle frame according to claim 17, wherein the axis having a primary shape is cut out from a metal sheet in the primary shaping step (*see Figure 17 and column 10 line 44*).

21-22: Mossner et al teach the manufacturing method of a resilient hinge of spectacle frame according to claim 17, wherein it also includes a step of shape the middle pillar of the axis by cutting (*see Figure 18 step I*).

23. Mossner et al teach the manufacturing method of resilient hinge of spectacle frame according to claim 17, wherein in the step of diameter reducing, the rear portion of the axis having a primary shape is compressed and stretch into a circular pillar with a specified diameter by using a diameter-reducing machine (*see column 10 lines 56-58, and note that stamping dies will inherently compress and stretch the pillar*).

24. Mossner et al teach the manufacturing method of a resilient hinge of a spectacle frame according to claim 17, wherein said method includes a step in which the

unwanted excess portion of the rear circular pillar of the axis that was produced by the diameter-reducing process can be cut out (*note that the stamping machines used to form the hinge member can be used to cut a portion of the rear circular pillar, although it is not explicitly disclosed*).

25. Mossner et al teach the manufacturing method of a resilient hinge of a spectacle frame according to claim 17, wherein a hinge hold in the male hinge structure of the head of the axis is punched in the hinge hole processing step (*see column 10 lines 63-65*).

26. Mossner et al teach the manufacturing method of a resilient hinge of spectacle frame according to claim 17, wherein the axis is manufactured from titanium (*see column 10 line 46*).

27. Mossner et al teach the manufacturing method of a resilient hinge of a spectacle frame according to claim 17, wherein it also includes a step of fitting a stopper (503), positioning guide (13), and a resilient medium (7) over the middle pillar to the rear pillar (9) (*see Figure 18*).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mossner et al (5,822,840) in view of Inoue (4,606,007).**

19-20. Mossner et al teach the manufacturing method of a resilient hinge of a spectacle frame according to claims 18 and 19, but fails to teach having a primary shape cut out with an NC EDM machine.

Inoue teaches an NC EDM used to machine a workpiece.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacturing the hinge of Mossner et al using the NC EDM machine of Inoue because it is highly efficient has good accuracy and finish (*see Inoue column 2 lines 1-3*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER P. TAOUSAKIS whose telephone number is (571)272-3497. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexander P Taousakis  
Examiner  
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